



UNITED STATES PATENT AND TRADEMARK OFFICE

PATENT EXAMINING OPERATIONS

#8
169
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Applicant: Seiji Yamashita Group Art Unit: 1741
Serial No.: 09/507,212
Filed: February 18, 2000 Docket No.: P 00 572.006
Title: METHOD AND APPARATUS FOR REDUCING CONTAMINATION IN A
PLASTIC CONTAINER

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Diane Thomas
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Birdwell, Janke & Durando, PLC
900 SW Fifth Avenue, Suite 1925
Portland, OR 97204

January 15, 2002

RESPONSE

Assistant Commissioner for Patents

Washington DC 20231

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FEB 15 2002

TC 1700

Greetings:

This is a response to the Office Action mailed October 26, 2001 in the above-captioned patent application.

Restriction Requirement

The present Office Action states: “The examiner would like to remind applicant that, while MPEP 806.05(f) pertains to claims directed to product and process of making and MPEP 806.05(h) [pertains] to claims directed to product and process of using, MPEP 806.05(e) pertains to claims directed to process and apparatus.”

Applicant reminds the Examiner that both MPEP 806.05(f) and MPEP 806.05(h) also pertain to claims directed to process and apparatus. In MPEP 806.05(f), the process is a process of making, and in MPEP 806.05(h), the process is a process of using, but these are processes nonetheless, so the Examiner’s statement demonstrates nothing.

MPEP 806.05(e) applies to distinctness between claims to a process and claims to an apparatus used to *practice* that process. An applying device such as a sprayer or immersion tank are examples of apparatus that could be used for *practicing* (or performing) the claimed process of coating a container. It should be obvious that the container is not capable of being used as an instrument for coating itself. Accordingly, 806.05(e) does not apply.

Rather, it is obvious that the container of claim 1 *results* from the method of claim 10. That is, the container of claim 1 is produced, manufactured, or “made” by the method of claim 10, so that 806.05(f) clearly applies as Applicant has asserted.

Applicant has also showed why the application cannot be restricted with respect to claim 2, and the Examiner has not responded at all to this showing. In sum, the Examiner has not followed the MPEP; the restriction requirement was and remains clearly improper.

Section 102 Rejections

Claims 10 - 13 stand rejected under 35 USC §102(b) as being anticipated by Goto et al., U.S. Patent No. 6,235,358 ("Goto"). The Examiner states that Goto teaches an apparatus for reducing contamination comprising a plastic container adapted for holding articles and a coating on selected portions of the container consisting essentially of titanium dioxide. The Examiner cites Goto (1) at the Abstract, (2) at Col. 3, lines 12 - 41, (3) at Col. 7, lines 2 - 6, and (4) at Col. 13, lines 12 - 15.

Applicant respectfully traverses the rejections.

Analysis of citations

The Abstract

In the Abstract, Goto recites a container closure having, on the outer surface, a coating layer of a resin composition comprising (a) an alicyclic epoxy resin, (b) a photo-cationic-curing catalyst comprising (1) a compound of the following formula, (2) a sensitizer comprising a thioxanthone sensitizer, and (3) a pigment comprising titanium dioxide of at least .30 mg per cm².

Col. 3, lines 12 - 41

At Col. 3, lines 12 - 41, Goto teaches a resin composition containing 1 to 20 parts by weight of the photocationic-curing catalyst, and 1.5 to 5 parts by weight of thioxanthone-type sensitizer per 100 parts by weight of titanium dioxide.

Col. 7, lines 2 - 6

At Col. 7, lines 2 - 6, Goto teaches that "[t]he ultraviolet-curable resin composition used in this invention may include the alicyclic epoxy resin, the specified sulfonium salt-type photo-cationic-curing catalyst, the thioxanthone-type sensitizer and titanium dioxide as essential components."

Col. 13, lines 12 - 15

At Col. 13, lines 12 - 15 Goto merely suggests that the plastic packaging containers may be bottles, cups, tubes, plastic cans, pouches or caps. This is not pertinent to any of the claims.

Argument

Applicant's claims require a coating that "consists essentially of" titanium dioxide. The transitional phrase "consisting essentially of" limits the scope of a claim to the specified materials or steps and those that do not materially affect the basic and novel characteristics of the claimed invention. MPEP 2111.03.

Applicant's specification makes it clear that a coating of titanium dioxide on a plastic container provides the basic and novel characteristics of the invention, to achieve the objectives of reducing contamination of semiconductor wafers in a plastic container at lower cost (see Applicant's specification at Page 2, lines 15 - 18).

Undoubtedly, adding extraneous ingredients to a given desired amount of the titanium dioxide coating will increase cost, defeating one of the objectives of the present invention. For this reason alone, Goto materially affects the basic and novel characteristics of the claimed invention, and Goto does not anticipate the claims.

More importantly, however, the additional ingredients may hamper the ability of the titanium dioxide to reduce contamination. This is certainly the case in Goto. Goto teaches including the titanium dioxide in *an epoxy resin*, for employing the titanium dioxide to absorb UV light rays. Assuming, *arguendo*, that the reference is not ambiguous¹, it teaches that the titanium dioxide

¹ If the reference is ambiguous it cannot be used as an anticipating reference for that reason alone. *In re Lind*, 264 F.2d 914, 916, 121 USPQ 222 (CCPA 1959).

molecules are coated with cured epoxy resin. For absorbing UV light rays, this coating presents no problem. However, to provide a hydrophilic coating for attracting water molecules (as stated in Applicant's specification at page 4, lines 11 - 21), and to attract organic molecules (as stated in Applicant's specification at page 5, lines 1 - 13), it is obvious that the titanium dioxide molecules must be exposed to the environment so that water and organic matter can come into contact therewith. Particularly, the titanium dioxide molecules cannot be sealed in an epoxy resin as they are in Goto or the invention cannot function.

Whatever other ingredients and quantities may be permitted by the language "consists essentially of," it is certain that ingredients and quantities that render the invention inoperable will materially affect the invention and are therefore excluded according to MPEP 2111.03. Hence, there is certainly no anticipation by Goto.

Claims 11 - 13 add additional subject matter which is claimed in combination with the patentable subject matter of claim 10. As it has been shown that Goto does not disclose the subject matter of claim 10 in the first instance, claims 11 - 13 are necessarily patentable for additional reasons which need not be discussed.

For the foregoing reasons, it is respectfully submitted that claims 1 - 18 are in condition for allowance and should issue in a single patent, and the Examiner is respectfully requested to withdraw the rejections as well as the restriction requirement and pass the entire case to issue.

Respectfully submitted,



Garth Janke

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**TRANSMITTAL LETTER
(General - Patent Pending)**

FEB 12 2002

Docket No.
P 00 572.006

In Re Application Of: Seiji Yamashita

Serial No.
09/507,212

Filing Date
February 18, 2000

Examiner
Tran, T.

Group Art Unit
1741

Title:

METHOD AND APPARATUS FOR REDUCING CONTAMINATION IN A PLASTIC CONTAINER

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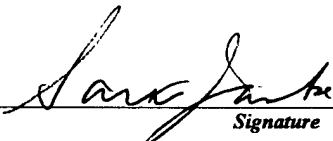
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Dated: January 15, 2002

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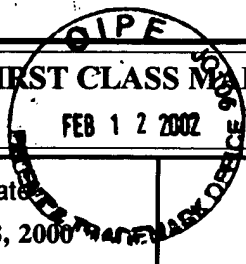
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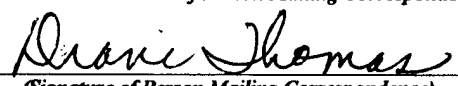


Serial No. 09/507,212	Filing Date February 18, 2000	Examiner Tran, T.	Group Art Unit 1741
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Invention:
METHOD AND APPARATUS FOR REDUCING CONTAMINATION IN A PLASTIC CONTAINER

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